

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendment and following remarks is respectfully requested.

Claims 21, 23-26, 28-33 and 45-47 are pending. In the present amendment, Claim 21, 25, and 26 are amended; Claims 22, 27, and 39-44 are canceled without prejudice or disclaimer; and new Claims 45-47 are added. Support for the present amendment can be found in the original specification, for example, at page 8, line 36 to page 9, line 10, at page 10, lines 17-23, at page 14, lines 29-33, at page 16, lines 16-20, in Fig. 1, and in Claims 22 and 27. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, the drawings were objected to; Claims 39-44 were objected to; Claims 21, 24-26, and 29-31 were rejected under 35 U.S.C. § 102(b) as anticipated by Ghosh (U.S. Patent No. 5,190,450); Claim 26 was rejected under 35 U.S.C. § 102(b) as anticipated by Fujii (U.S. Patent No. 5,660,480); Claims 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ghosh in view of Yamamoto (U.S. Patent No. 6,874,942); Claims 27 and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Fujii in view of Yamamoto; Claims 32 and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ghosh in view of Bishop (U.S. Patent No. 6,139,261); and Claim 33 was rejected under 35 U.S.C. § 103(a) as unpatentable over Fujii in view of Bishop.

With respect to the objection to the drawings, Claim 25 is amended to clarify that the grooves are formed in the housing, which are shown in Fig. 2 of the present application. Accordingly, it is respectfully requested that the objection to the drawings be withdrawn.

With respect to the objection to Claims 39-44, Claims 39-44 are hereby canceled without prejudice or disclaimer. Accordingly, it is respectfully requested that the objection to Claims 39-44 be withdrawn.

Turning now to the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), Applicants respectfully request reconsideration and withdrawal of these rejections, as discussed below.

Claims 21 and 26 are amended to include features of Claims 22 and 27, respectively, and recite, in part, “a coating...including a mixture of one or more wear-resistant materials selected from the group consisting of Si, cubic BN, TiC, WC, SiC, Cr₃C₂, ZrO₂-Y and TiB, and one or more solid lubricants selected from the group consisting of hexagonal BN, Cr₂O₃, WS₂ and BaZrO₄.” The Office Action rejects Claims 21 and 26 based on Ghosh and Fujii, respectively, but acknowledges that these references do not disclose the features of Claims 22 and 27 presently recited in Claims 21 and 26. Instead, the Office Action relies on Yamamoto to cure the deficiencies of Ghosh and Fujii.

Yamamoto describes in col. 7, lines 28-35 a coated layer of a solid lubricant such as fluoroplastics, hexagonal boron nitride, **or** a material of excellent wear resistance such as TiC. Thus, Yamamoto does not disclose or suggest “a **mixture** of one or more wear-resistant materials...and one or more solid lubricants,” as recited in Claims 21 and 26.

Additionally, Yamamoto in col. 7, lines 34-35 describes resin coating, disperse plating, and vapor deposition as methods for coating the layer on a bearing. It is respectfully submitted that a person of ordinary skill in the art would recognize that these methods only enable formation of a coating of a pure substance, not a mixture of materials. Thus, a person of ordinary skill in the art would have no expectation of success of obtaining “a **mixture** of one or more wear-resistant materials...and one or more solid lubricants,” based on Yamamoto. Without an expectation of success, the rejection based on obviousness is improper. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976); *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 U.S.P.Q.2d 1016 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991).

Therefore, reconsideration and withdrawal of the outstanding grounds for rejection of independent Claims 21 and 26, and all claims dependent thereon, is respectfully requested.

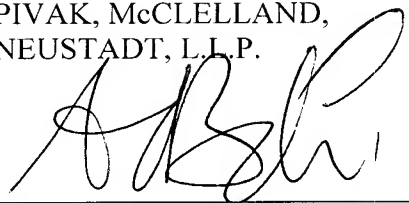
Claims 23, 28, 32, and 33 depend on Claims 21 and 26, and thus are believed to be patentable for at least the reasons discussed above with respect to Claims 21 and 26. Further, it is respectfully submitted that the remaining cited reference (Bishop) does not cure the above-noted deficiencies of Ghosh, Fujii, and Yamamoto. Thus, it is respectfully requested that the rejections of Claims 23, 28, 32, and 33 be withdrawn.

New Claims 45-47 are added by the present amendment. Support for new Claims 45-47 can be found in the original specification, for example, at page 8, line 36 to page 9, line 10, and in Fig. 1. Thus, it is respectfully submitted that no new matter is added. New Claims 45-47 depends on Claims 21 and 26, and thus are believed to be patentable for at least the reasons discussed above with respect to Claims 21 and 26. Accordingly, it is respectfully requested that new Claims 45-47 be allowed.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A notice of allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Adnan H. Bohri
Registration No. 62,648